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San Jose, CA 95113

EXAMINER

SAID, MANSOUR M

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,274

Applicant(s)

NICOLAS ET AL.

Examiner

MANSOUR M SAID

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/18/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Reconsideration

1. This office action is in respond to the reconsideration respond filed on June 18, 2004

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-5, 7, 10, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani (5,483,262) in view of Uchida (5,067,573).

As to claims 1, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus, digitizer (the input type information processor, (figures 1-2, (10))); a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer (the input type information processor, (figures 1-2, (10))), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1))); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) , a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen

(figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

Izutani does not teach an opening at one end of the slot and a non-mechanical detector for detecting the stylus.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 3, 59-67) and a non-mechanical detector for detecting the stylus (column 5, lines 15-30).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 4, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23)) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 5, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

As to claims 7 and 17, Izutani teaches an on/off button (power switch, (figure 2, (3)) for placing the processor (CPU, (figure 1, (11)) (column 4, lines 30-35), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) into the power conservation mode when pressed while the computer system is powered on and wherein the on/off button is for powering on the processor (column 1, lines 62-67 & column 2, lines 1-6), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input

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type information processor, (figures 1-2, (10)) when pressed while the computer system is in the power conservation mode (column 1, lines 62-67 & column 2, lines 1-6).

As to claim 10, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus; a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer, (the input type information processor, (figures 1-2, (10)), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1))); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) , a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen (figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

Izutani does not teach an opening at one end of the slot and a non-mechanical detector for detecting the stylus.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 59-67) and a non-mechanical detector for detecting the stylus (column 5, lines 15-30).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 16, Izutani teaches that constantly supplying power (power supply unit, (figure 1, (19)) to the memory unit (figure 1, (13-14)) (column 2, lines 55-67).

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4. Claims 3, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claims 1 and 10 above, and further in view of Ogawa (6,100,538).

As to claims 3, 6, 11 and 13, Izutani and Uchida teach all claimed limitation except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Izutani's modified device so as to provide an optical digitizer capable of operating with stability with out being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

As to claim 14, Uchida teaches the detector is located within the slot (pen receptacle, (figures 1-2, (23))) and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 15, Uchida teaches the computer system is a palmtop computer system (hand-writing input apparatus, (figures 1-3)) (abstract and column 2, lines 31-67).

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5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claims 1 above, and further in view of Dao et al. (5,049,862; hereinafter referred to Dao).

As to claim 8, Izutani and Uchida disclose all claimed limitations except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14); and a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Dao's portable computer having alphabetic and numeric character into Izutani's modified device to allow real-time coupling of manual paper form completion into machine recognizable form (column 1, lines 1-10).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim above, and further in view of Snell (5,756,941).

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Izutani and Uchida disclose all claimed limitation but omit that the digitizer is separate in area from the display.

However, Snell teaches that the digitizer is separate in area from the display (column 3, lines 50-67).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Snell's teaching into Izutani's modified system so as to increase the versatility of the device.

7. Claims 18-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani (5,483,262) in view of Uchida (5,067,573).

As to claims 18, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus, digitizer (the input type information processor, (figures 1-2, (10))); a case (unit, (figure 1, (17) for supporting the processor (column 1, lines 5-10), the memory unit ((figure 1, (13 & 14)), and the display screen (display unit, (figure 2a, (6)) and the digitizer (the input type information processor, (figures 1-2, (10)), the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1))); a power (power switch, (figure 2, (3)) ,slot (holder, (figure 2, (2)) (column 3, lines 38-46) , a switch (power switch, (figure 2, (3)) coupled to power up the processor the display screen (figure 9) (column 1, lines 11-22), a power conservation mode when the stylus is inserted into the slot (column 1, lines 62-67 & column 2, lines 1-6).

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Izutani does not teach an opening at one end of the slot; a non-mechanical detector for detecting the stylus and a hinge.

However, Uchida teaches an opening at one end of the slot (pen receptacle, (figures 1-2, (23)) and column 3, 59-67); a non-mechanical detector for detecting the stylus (column 5, lines 15-30) and a hinge (hinge member, (figures 1-2, (9)) and column 2, lines 2, lines 45-52).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Uchida's teaching detecting the stylus into Izutani's pen input device so to effect a mode change (column 2, lines 10-11).

As to claim 19, Uchida teaches wherein the detector is located within the slot (column 5, lines 15-30).

As to claim 20, Uchida teaches wherein the detector is located within the slot and is an electrical detector (detector associated with receptacle, (23), (column 1, lines 49-56).

As to claim 21, Uchida (figures 2a-2c) teaches wherein the computer system is a palmtop computer system (figures 1-3)) (abstract and column 2, lines 31-67).

As to claim 23, Izutani teaches an on/off button (power switch, (figure 2, (3)) for placing the processor (CPU, (figure 1, (11)) (column 4, lines 30-35), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) into the power conservation mode when pressed while the computer system is powered on and wherein the on/off button is for powering on the processor (column 1, lines 62-67 & column 2, lines 1-6), the display screen (display unit, (figure 2, (6)) and the digitizer (digitizer (the input type information processor, (figures 1-2, (10)) when pressed while the computer system is in the power conservation mode (column 1, lines 62-67 & column 2, lines 1-6).

8. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim 18 above, and further in view of Ogawa (6,100,538).

Izutani and Uchida teach all claimed limitations in claim 22 except that optical detector and a battery, which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Izutani's modified device so as to provide an optical digitizer capable of operating with stability without being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani in view of Uchida as applied to claim 18 above, and further in view of Dao et al. (5,049,862; hereinafter referred to as Dao).

Izutani and Uchida disclose all claimed limitations in claim 8 except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to have Dao's teaching into Izutani's modified system so as to increase the versatility of the display device.

Response to Arguments

10. Applicant's arguments filed 6/18/04 have been fully considered but they are not persuasive. On page 3, Applicant argued that "Izutani does not teach or suggest a computer system comprising a slot for receiving a stylus wherein the slot has an opening at one end of the slot for receiving a stylus".

Examiner respectfully disagrees, Izutani teaches an information processor having a pen holder (figure 2a-2c, (2)) for holding the pen (column 3, lines 1-16). The pen holder does not expressly show that the slot has an opening at one end of the slot for receiving a stylus".

However, Examiner cited Uchida that teaches an electronic tablet, which receives handwritten input via an input pen (figures 1-3 and column 2, lines 30-40), and the slot has an opening at one end of the slot (figures 1-2, (23) for receiving a stylus (column 3, lines 59-67).

On page 4, Applicant argued that “pen holder 2 does not have an opening at one end for receiving input pen 1. Rather, the pen-holder of Izutani has an upper pen holding portion 4 at one end and a lower pen holding portion 5 at the other end.

Examiner previously stated that Uchida fairly discloses the claimed limitations “the slot has an opening at one end of the slot (figures 1-2, (23) for receiving a stylus (column 3, lines 59-67).

On page 5, Applicant argued that “the combination of Izutani and Uchida fails to teach or suggest this claim limitation because Uchida does not overcome the shortcomings of Izutani. Uchida, alone or in combination with Izutani, does not show or suggest a computer system comprising a non-mechanical detector for detecting a stylus in a slot, wherein the slot has an opening at one end for receiving the stylus”.

However, Examiner respectfully disagrees for the following reasons, Izutani clearly teaches an information processor having a penholder and a push type power switch provide on the pen holder (figure 2a-2c, (2)) and (column 3, lines 1-16).

Izutani omits the claimed limitations such as “a non-mechanical detector for detecting a stylus in a slot, wherein the slot has an opening at one end for receiving the stylus”.

However, Uchida fairly teaches a non-mechanical detector for detecting a stylus in a slot (column 5, lines 15-30). Wherein the slot has an opening (figures 1-2, (23)) at one end for receiving the stylus (column 3, 59-67).

On pages 6-7, Applicant argued that “the combination of Izutani, Uchida and Ogawa fails to teach or suggest this claim limitation because Ogawa does not overcome the shortcomings of Izutani and Uchida. The combination of Izutani, Uchida and Ogawa would require the above-described modification of Izutani, rendering Izutani inoperable.

However, Examiner respectfully disagrees for the following reasons, Izutani and Uchida fairly disclose the claimed limitations of claims 3, 6, 11 and 13, but they omit expressly to disclose optical detector and a battery which is supply power to the computer.

Examiner cited Ogawa’s device having an optical digitizer comprising “optical detector (figure 3L and 3R) column 6, lines 40-67) and a battery which is supply power to the computer” (column 2, lines 40-67, column 13, lines 1-25).

On pages 8-9, Applicant argued that “the combination of Izutani, Uchida and Dao fails to teach or suggest this claim (claim 8) limitations because Dao does not overcome the shortcomings of Izutani and Uchida.

However, Examiner respectfully disagrees for the following reasons, Izutani and Uchida fairly disclose the claimed limitations of claim 8, but they omit expressly to disclose a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

Dao fairly discloses a first region for capturing stroke data associated with alphabetic characters (figure 8, column 7, line 42 through column 8, line 3) and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

On pages 9-10, Applicant argued that “Izutani, Uchida and Snell fail to teach or suggest this claim (claim 8) limitations because Dao does not overcome the shortcomings of Izutani and Uchida.

However, Examiner respectfully disagrees for the following reasons, Izutani and Uchida fairly disclose the claimed limitations of claim 9, but they omit expressly to disclose the digitizer is separate in area from the display.

Snell device fairly teaches that the digitizer is separate in area from the display (column 3, lines 50-67).

On pages 10-13, Applicant argued that “Applicants respectfully submit that Izutani does not show, teach or suggest a computer system comprising a slot for receiving a hinge attached to a protective cover, a non-mechanical detector for detecting a position of a hinge, and a switch for controlling power based on a position of a hinge, as claimed. In particular, Izutani makes no reference at all to a hinge”.

However, Examiner respectfully disagrees for the following reasons, Izutani fairly discloses the claimed limitations, but he omits expressly to disclose an opening at one end of the slot, a non-mechanical detector for detecting the stylus and a hinge

Uchida that teaches an electronic tablet, which receives handwritten input via an input pen (figures 1-3 and column 2, lines 30-40), and the slot, has an opening at one end of the slot (figures 1-2, (23) for receiving a stylus (column 3, lines 59-67).

On page 13, Applicant argued that “the present invention as recited in claim 22 is not unpatentable over Izutani and Uchida, further in view of Ogawa.

However, Examiner respectfully disagrees for the following reasons, Izutani and Uchida fairly disclose the claimed limitations of claim 22, but they omit expressly to disclose optical detector and a battery, which is supply power to the computer.

Examiner cited Ogawa's device having an optical digitizer comprising "optical detector (figure 3L and 3R) column 6, lines 40-67) and a battery which is supply power to the computer" (column 2, lines 40-67, column 13, lines 1-25).

Furthermore, on pages 14-15, Applicant argued that "Dao does not teach, describe or suggest a non-mechanical detector for detecting a position of a hinge, and a switch for controlling power based on a position of a hinge".

However, Examiner respectfully disagrees for the following reasons, Izutani and Uchida fairly disclose the claimed limitations of claim 22, but they omit expressly to disclose a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

Dao fairly discloses a first region for capturing stroke data associated with alphabetic characters (figure 8, column 7, line 42 through column 8, line 3) and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

The combination of all references fairly teaches the claimed limitations, and therefore all references should be taken in combination and not individually. The Applicant cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In re Keller, 208 USPQ 871 (CCPA 1981).

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is **not** mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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Or faxed to:

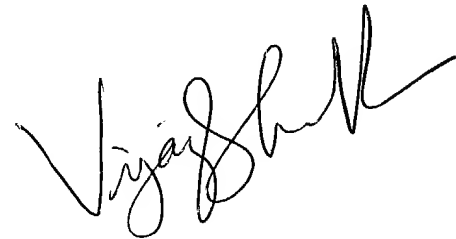
(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office
Whose telephone number is (703) 306-0377.

August 15, 2004

Mansour M. Said

A handwritten signature in black ink, appearing to read 'Vijay Shankar', written in a cursive style.

**VIJAY SHANKAR
PRIMARY EXAMINER**